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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,419	01/25/2002	Craig L. Schmidt	P-7586.01	1349

27581 7590 06/22/2004

MEDTRONIC, INC.  
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EXAMINER

SCHAETZLE, KENNEDY

ART UNIT PAPER NUMBER

3762

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/057,419	<b>Applicant(s)</b> SCHMIDT ET AL.	
	<b>Examiner</b> Kennedy Schaetzle	<b>Art Unit</b> 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/10/02, 5/27/03.</u> | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: the status of the application listed on page 1 must be updated.

Appropriate correction is required.

### *Claim Objections*

2. Claims 14 and 17 are objected to. Regarding claim 14, the phrase "central circuit" lacks antecedent basis. The examiner will assume it was the applicants' intent to refer to the *control* circuit rather than the *central* circuit. Regarding claim 17, the claim dependency is clearly in error. The examiner will assume it was the applicants' intent to refer back to claim 16. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4, 6-15, 18, 19, 21 and 23-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Barreras, Sr. et al. (Pat. No. 5,733,313).

Regarding claim 1, Barreras, Sr. et. al. (Barreras) disclose first and second power sources 44 and 62, a control circuit 46 coupled to the first power source to control the operation of the apparatus, the control circuit being adapted to receive power from the first power source, and a communication circuit (that circuitry generally associated with receiving and transmitting data and power via link 61 and inductor 60) coupled to the second power source (via inductive coupling) to communicate with an external device (26, 40, etc.), the communication circuit being adapted to receive power from the second power source. Related comments apply to independent claims 18 and 28.

Art Unit: 3762

Applicants should note that claim 1 is so unduly broad that it reads on a host of common use devices. For example, a person talking on a cell phone while driving a car would infringe on the claim if the examiner were to pass this claim in present form to issue. In this case, the automobile has a first power source (e.g., the car battery or fuel) for controlling a variety of control circuits, with the cell phone having a communication circuit coupled to its own rechargeable battery. The examiner suggests in the very least to narrow the scope of the claims to medical devices (a mere recitation in the preamble that the apparatus is a medical device will be considered insufficient) and to recite some structural relationship between the elements to avoid Final rejection.

Regarding claim 6, note col. 8, lines 21-32. Related comments apply to claim 9.

Regarding claim 7, note col. 8, lines 33-43. Related comments apply to claim 10.

Regarding claim 8, the applicants have not invoked the 6<sup>th</sup> paragraph of §112 and therefore any sensor capable of performing the recited function of sensing the remaining power level of the second power source below a remaining power level threshold would reasonably read on the claim. As disclosed by Barreras, the sensor can detect when the transmitter is moved away from the receiver or is zero volts in the absence of RF energy (see col. 8, lines 21-32). A battery too weak to generate a transmission signal to the implant would cause the implant to "think" the transmitter was removed from the receiver. The implant is therefore capable of sensing a low battery power condition.

Regarding claims 11 and 12 and claims of similar wording, note col. 12, lines 25-30.

Regarding claim 14, note col. 11, lines 44-67.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 5, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barreras, Sr. et al. (Pat. No. 5,733,313).

Barreras, Sr. et al. do not concern themselves with battery chemistry specifics. The examiner takes Official Notice that lithium chemistry batteries, such as lithium manganese dioxide, lithium silver vanadium oxide, lithium-ion, etc., and nickel/metal-hydride batteries are old and well known to those artisans of ordinary skill in the rechargeable battery arts. To employ such ubiquitous battery chemistry in the device of Barreras would have therefore been considered blatantly obvious. Clearly the choice of battery depends on the intended use and thus power requirements of the circuits within which the batteries are placed. The applicants further give no criticality over one known battery chemistry over the other, in fact stating that a wide variety of battery configurations and chemistries may be employed (see pages 8 and 9 of the present specification).

7. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barreras, Sr. et al. (Pat. No. 5,733,313) in view of Adams et al. (Pat. No. 5,372,605).

Barreras does not discuss the use of a high-rate cell and a low-rate cell for the implant. Adams et al., however, teach that it is highly advantageous to incorporate such a configuration into an implant such as a pacer/cardioverter/defibrillator in order to maximize efficiency and prolong implant life by utilizing the strengths of each cell (see both "Background of the Invention" and "Summary of the Invention"). Any artisan concerned with enhancing efficiency and thus maximizing the life of the implant—very important concerns for any medical implant device manufacturer—would have seen the obviousness of incorporating a high-rate cell for powering high output circuits such as the defibrillator shock generating circuit, and a low-rate cell for powering those circuits not demanding such a high output such as control and monitoring circuitry.

Art Unit: 3762

**Conclusion**

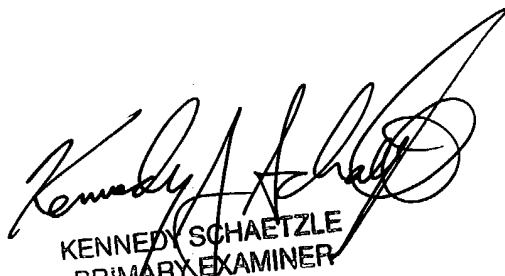
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kennedy Schaetzle whose telephone number is 703 308-2211. The examiner can normally be reached on 9:30 -6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703 308-0851. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KJS  
June 19, 2004



KENNEDY SCHAETZLE  
PRIMARY EXAMINER